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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,879	12/31/2003	Michael E. Browne	POU920030116US1	8880

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ALBANY, NY 12203

EXAMINER

CABUCOS, MARIE G

ART UNIT	PAPER NUMBER
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2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/749,879

Applicant(s)

BROWNE ET AL.

Examiner

Marie Antoinette Cabucos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/31/2003 and amendment filed 12/21/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-20 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: it is unclear as to where the "anticipated request comes from and how it is related to "a request claimed in claim 1, lines 3.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-20 are directed towards method steps, which can be practiced mentally in conjunction with pen and paper, therefore, they are directed to non-statutory subject matter. Specifically, as claimed, it is uncertain what performs each of the method steps. The claimed steps do not define a machine or computer implemented process.

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3. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Claims 1-20 lacks a useful, concrete and tangible result because the process, systems and methods appear to be directed at software per se which is a functional descriptive material per se that is a non-statutory subject matter.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being unpatentable by Gladney et al (US Patent no. 6,044,373).

Regarding claims 1, 4, 8, 11, 15 and 18, Gladney discloses in figures 3-9 a request management system and method for a communications environment, and a program storage device containing means for receiving by a manager (210) a request associated with meta data (230), said meta data corresponding to data (220) maintained separately from the meta data; and means for informing (cols. 9-10) by the manager, another manager (310) of an anticipated request to be received by the another manager to enable the another manager to prepare for the anticipated request.

6. Regarding claims 2, 9, and 16, Gladney discloses in figures 3-9 a request management system and method for a communications environment, and a program storage device containing means for receiving by a manager a request associated with

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meta data (230), of claims 1, 8 and 15 respectively, further comprising means for preparing by the another manager for the anticipated request, said means for preparing responsive to said means for informing (figure 4; col. 10 lines 20-53).

7. Regarding claims 3, 10 and 17, Gladney discloses in figures 3-9 a request management system and method for a communications environment, and a program storage device containing means for receiving by a manager a request associated with meta data (230), of claims 1, 8 and 15 respectively, wherein said means for preparing comprises means for managing contents of a cache in a data storage subsystem (figure 4).

8. Regarding claims 5, 12, and 19, Gladney discloses in figures 3-9 a request management system and method for a communications environment, and a program storage device containing means for receiving by a manager a request associated with meta data (230), of claims 1, 8 and 15 respectively, further comprising means for sending, by the manager, a reply to a communication unit in response to the request substantially simultaneously with informing the another manager of the anticipated request to be received; and means for receiving, by the another manager, the anticipated request, wherein said means for preparing begins prepare for the anticipated request before the means for receiving receives the anticipated request (col. 11, lines 5-19; plus cols. 12-13).

9. Regarding claims 6, 7, 13, 14 and 20, Gladney discloses in figures 3-9 a request management system and method for a communications environment, and a program storage device containing means for receiving by a manager a request associated with

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meta data (30), of claims 1, 8 and 15 respectively, wherein said means for managing contents comprises means for pre-fetching one or more data blocks from one or more storage media of the data storage subsystem whereby the data blocks are stored in the cache, the data blocks comprising at least some of the data (col. 12, lines 21-55); and wherein said means for managing contents comprises means for releasing storage locations (320) of the cache (312) whereby the storage locations become available for storing other data, the storage locations storing data blocks comprising at least some of the data (cols. 19-10).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Inquiry

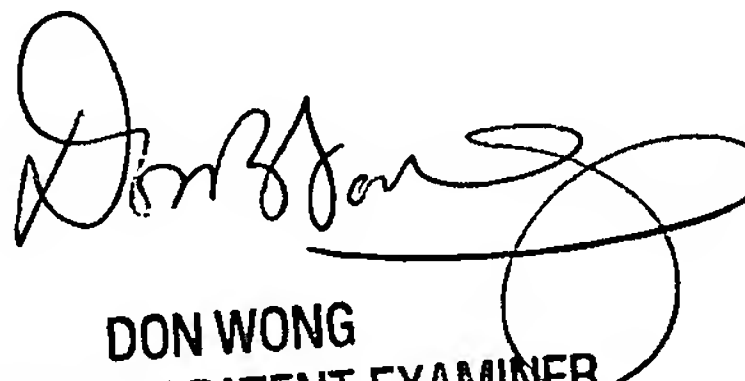
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie Antoinette Cabucos whose telephone number is 571-272-8582. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don K. Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marie Antoinette Cabucos
Examiner
Art Unit 2163



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